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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/722,085 | 11/25/2003 | David W. Boykin | 421/60/20/2 | 7150 |
| 25297 | 7590 | 11/29/2004 | EXAMINER | |
| JENKINS & WILSON, PA 3100 TOWER BLVD SUITE 1400 DURHAM, NC 27707 | | | SOLOLA, TAOFIQ A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1626 | |

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|---|---|--|
| <p align="center">Office Action Summary</p> | <p>Application No.</p> <p>10/722,085</p> | <p>Applicant(s)</p> <p>BOYKIN ET AL.</p> | |
| | <p>Examiner</p> <p>Taofiq A. Solola</p> | <p>Art Unit</p> <p>1626</p> | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: ____.</p> |
|--|---|

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Claims 1-11 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to disclose that all known bis-aryl diamidoxime compounds, all amidoxime aryl halides and all 2,5-bis trialkylstannanes are embraced by the instant process. This is also true for aprotic solvents and palladium catalysts. The starting reagents, catalyst, etc. are critical elements of the invention and must be sufficiently disclosed (identified). No exclusive definitions of these elements are disclosed in the specification. Rather, few examples are cited and only one working example is disclosed for each element. Therefore, the specification fails to provide adequate support for claims 1-11. Applicant may not claim all amidoxime aryl halides, all 2,5-bis trialkylstannanes, aprotic solvents and palladium catalysts, known and yet to be discovered, that may or may not be applicable in the instant process. Applicant must claim only amidoxime aryl halides, 2,5-bis trialkylstannanes, aprotic solvents and palladium catalysts that embody Applicant's invention, having support in the specification.

Applicant must show possession of the invention by describing it with all the claimed limitations. *Lookwood v. American Airlines Inc.* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966

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(Fed Cir. 1997). By adding the structure of 2,5-bis tributylstannylfuran replacing the furan oxygen with Q, and add claims 2-3, 6-7 to claim 1 the rejection would be overcome.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "comprises", line 2, claim 2, renders the claim indefinite. The term is open-ended and may not be used in reference to a compound. By replacing "compound comprises" with "compounds have" the rejection would be overcome.

Claim 1 fails to define bis-aryl diamidoxime compounds, amidoxime aryl halides, 2,5-bis trialkylstannanes, identify aprotic solvents and palladium catalysts so as to determine the metes and bounds of claims 1-11. Therefore, the claims are indefinite. A claim must stand alone to define the inventions, and incorporation into the claims by reference to the specification or an external source is not permitted. Ex parte Fressola, 27 USPQ 2d 1608, BdPatApp & Inter. (1993). In patent examination, it is essential for claims to be precise, clear, correct, and unambiguous. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). See the Examiner's suggestion above under 35 USC 112, first paragraph.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD. whose telephone number is (571) 272-0709.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

TAOFIQ SOLOLA
PRIMARY EXAMINER


TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1626

November 23, 2004